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10/530,898	04/11/2005	Alain Durand	PF020142	9206
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Joseph J. Laks			EXAMINER	
Thomson Licensing LLC			ABYANEH, ALI S	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/530,898

**Applicant(s)**

DURAND ET AL.

**Examiner**

ALI S. ABYANEH

**Art Unit**

2437

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. Claims 1-10 are presented for examination.
2. Claims 1-10 are amended.
3. Examiner withdraws the 101 rejection to the claim 1 due to the correction by the applicant.
4. Examiner withdraws the objections to the claims 1-10 due to the correction by the applicant.
5. Examiner withdraws the 112 second paragraph rejection to the claim 5 due to the correction by the applicant.

#### **Response to Arguments**

6. Applicant's amendments/arguments filed on 08-13-2008 have been fully considered but they are not persuasive.

Throughout the remakes applicant argues and describes as how the applicant's invention and applied prior art are directed to different problems and solutions. Examiner would like to point out that Applicant must discuss the references applied against the claims, specifically explain how the claims overcome or distinguish from the references.

In page 7 of the remarks applicant argues "Matsushima does not teach a methods for preventing the illegal exportation of content from a global copy protection system to a local copy protection system". Examiner respectfully disagrees.

Applicant's arguments in the remarks do not provide a clear distinction (based on the claimed limitations and claimed language not the specification) between the global or local copy protection system of the claims and copy protection systems in Matsushima. Furthermore claims do not explicitly specify as what global or local copy protection systems are, therefore claims are interpreted broadly but reasonably. Matsushima discloses a system for preventing illegal check-out and recording of a protected content. In Matsushima a content management apparatus performs and controls check-in and check-out on the content according to a right management information, this reads on the claimed limitation of global copy protection system of the claim. Matsushima further discloses a portable media that records content from a content management apparatus 3 and a playback apparatus 2 that plays audio data. This is functionally equivalent to the claimed limitation of local copy protection system (see paragraph [0054] and fig. 1).

In page 8 of the remarks applicant further argues "Matsushima does not teach anything related to exporting content from a global CPS or converting content from a global CPS into a local CPS". Examiner respectfully disagrees.

Matsushima teaches converting content in content management apparatus and exporting the content from content management apparatus to a portable memory card (see paragraph [0078], wherein the check-out unit 22 in content management apparatus converts contents and records the converted content in the portable memory).

In view of above discussion examiner maintains the rejection as follows:

**Claim Rejections - 35 USC § 101**

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claim 10 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 10 calls for a device that does not include any hardware. Applicant has amended the claim to include "store" in order to overcome the 101 rejection. However claim does not recite a hardware for storage. As such, the claim does not fall within any of the four statutory classes.

**Claim Rejections - 35 USC § 102**

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsushita et al. (US Publication No.2002/0161571).

**Regarding claim 1**

Matsushima teaches a device for preventing illegal exportation of a content protected by a global copy protection system to a local copy protection system, wherein each content liable to be exported comprises a unique identifier and wherein the device comprises a memory for storing an exportation table that includes a unique identifiers of all contents that have already been exported through said device (paragraph [0059]).

**Regarding claim 2**

Matsushima furthermore teaches a device, wherein the unique identifier is contained in a part of the content protected by encryption or authentication and wherein the device further comprises means for extracting said unique identifier from the content (paragraph [0055]).

**Regarding claim 3**

Matsushima furthermore teaches a device, wherein the exportation table is stored in a secure memory of the device (paragraph [0113]).

**Regarding claim 4**

Matsushima furthermore teaches a device, wherein the exportation table is stored in an encrypted or authenticated form in a conventional memory of the device and wherein the encryption key or authentication key used to encrypt or authenticate the exportation table is stored in a secure memory (paragraph [0113]).

**Regarding claim 5**

Matsushima furthermore teaches a device wherein the device is comprised in a local network protected by a global copy protection system (paragraph [0177]).

**Regarding claim 6**

Matsushima furthermore teaches a device, wherein the device is one of a set of devices comprised in a local network protected by a global protection system, each of the devices in the set for preventing the illegal exportation of the content protected by the global copy protection system to the local copy protection system (paragraph [0177]).

**Regarding claim 7**

Matsushima furthermore teaches a device, wherein the exportation table stored in said device further contains, for each unique identifier a counter of the number of exportations of the content associated with said unique identifier, this counter being incremented each time an exportation is made through said device (paragraph [0179]-[0180]).

**Regarding claim 8**

Matsushima teaches a method for recording a content received by a device, said device for preventing illegal exportation of a content protected by a global copy protection system to a local copy protection system, each content liable to be exported comprising a unique identifier (paragraph [0059]), the device including an exportation

table storing unique identifiers of all contents that have already been exported through said device (paragraph [0098]), said method comprising the steps of:

if the copy is to be made for the local copy protection system, checking whether the unique identifier of said content is comprised in the exportation table of said device; and

should said checking be positive, then preventing the recording; and  
should said checking be negative, then recording the content and storing said unique identifier in said exportation table (paragraph [0180]).

#### **Regarding claim 9**

Matsushima teaches a method for recording a content received by a device, said device for preventing illegal exportation of a content protected by a global copy protection system to a local copy protection system, each content liable to be exported comprising a unique identifier (paragraph [0059] ), the device including an exportation table storing unique identifiers of all contents that have already been exported through said device and a count of the number of exportations of the content associated with said unique identifier, the count being, incremented each time an exportation is made through said device (paragraph [0098]), said method comprising the steps of:

if the copy is to be made for a local copy protection system,  
(a) checking whether the unique identifier of said content is contained in the exportation table of said device; and  
should said checking of step (a) be positive, then



(b) checking whether a predetermined maximum number of authorized copies has been reached by the counter associated with the unique identifier, and

in case the maximum number of copies has been reached, then preventing the recording; and in case the maximum number of copies has not been reached, then incrementing the counter and recording the content; and

should said checking of step (a) be negative, then recording the content and storing said unique identifier in said exportation table(paragraph [0195]-[0198]).

#### **Regarding claim 10**

Matsushima teaches a device for preventing illegal exportation of a content protected by a global copy protection system to a local copy protection system, said device being adapted to be linked to a local network protected by e the global copy protection system .and to convert a content it receives into a content protected by said global copy protection system, and wherein said device is furthermore adapted to generate and store a unique identifier for each content it converts, the unique identifier being inserted in a part of the content protected by encryption or by authentication (paragraph [0055]).

### **Conclusion**

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Abyaneh whose telephone number is (571) 272-7961. The examiner can normally be reached on Monday-Friday from (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone numbers for the organization where this application or proceeding is assigned as (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/A. S. A./

Examiner, Art Unit 2437

/Emmanuel L. Moise/

Supervisory Patent Examiner, Art Unit 2437